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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,188	12/02/1999	SHOICHI YAMAGUCHI	862.3158	9981
5514	7590	11/10/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			WON, YOUNG N	
		ART UNIT		PAPER NUMBER
		2155		12
DATE MAILED: 11/10/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/452,188	YAMAGUCHI, SHOICHI
	Examiner Young N Won	Art Unit 2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 September 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

1. Amended claims 1, 10, and 18 have been examined and all dependent claims have been re-examined. Claims 1-18 are pending with this action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (US Pat No.5608786).

#### *Independent:*

As per claims 1 and 10, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") and a method (see col.1 lines 5-13) connected to a communication network (see Fig.1, #4 & #10), said apparatus and method comprising: destination designating means for designating a destination apparatus (see col.2, lines 25-28 & 44-54); facsimile communication means for transmitting the transmission information inputted by said input means to a destination apparatus in accordance with

facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); encryption means for encrypting the transmission information inputted by said input means (see col.9, lines 18-33) without using the communication network, wherein the transmission information is encrypted before transmitted through the communication network to maintain confidentiality of the transmission information (see col.9, lines 26-33); electronic-mail communication means for transmitting the transmission information inputted by said input means or encrypted by said encryption means to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); communication designating means for causing transmission of the transmission information by selecting either said facsimile communication means or said electronic-mail communication means (see col.2, lines 44-54 and col.3 lines 36-38); security designating means for designating whether the transmission information is confidential information (see col.9, lines 28-33); and control means for controlling said facsimile communication means, said encryption means, and said electronic-mail means such that (see col.9, lines 19-26: it is inherent that when Gordon says "transparently to the sender and the receiver", there is a means of control by the "state of the art" system) if the transmission information has been designated as being confidential information by said security designating means, said facsimile communication means transmits the transmission information to the destination apparatus by facsimile transmission (see col.2, lines 50-54 and col.9 lines 23-26) through the communication network, when said facsimile communication means has been designated by said communication designating means (see col.3, lines 30-35),

and said electronic-mail communication means sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication means has been designated by said communication designating means (see col.2 lines 31-35 and col.2, lines 30-35).

Gordon does not explicitly teach of an input means for inputting transmission information to be transmitted to the destination apparatus designated by said destination designating means without using the communication network, but it is inherent that all devices used for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner (see Fig.1), all have an input means such as number pad, keyboard, mouse, and software to input telephone numbers or email addresses.

As per claim 18, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said apparatus comprising: a destination designating unit adapted to designate a destination apparatus (see col.2, lines 25-28 & 44-54); a facsimile communication unit adapted to transmit the transmission information inputted by said input unit to a destination apparatus in accordance with facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); an encryption unit adapted to encrypt the transmission information inputted by said input unit (see col.9, lines 18-33) without using the communication network, wherein the transmission information is encrypted before transmitted through the communication network to maintain confidentiality of the transmission information (see col.9, lines 26-33); an electronic-mail communication unit

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adapted to transmit the transmission information inputted by said input unit or encrypted by said encryption unit to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); a communication designating unit adapted to cause transmission of the transmission information by selecting either said facsimile communication unit or said electronic-mail communication unit (see col.2, lines 44-54 and col.3 lines 36-38); a security designating unit adapted to designate whether the transmission information is confidential information (see col.9, lines 28-33); and control unit adapted to control said facsimile communication unit, said encryption unit, and said electronic-mail communication unit (see col.9, lines 19-26: it is inherent that when Gordon says "transparently to the sender and the receiver", there is a means of control by the "state of the art" system) such that, if the transmission information has been designated as being confidential information by said security designating unit, said facsimile communicating unit transmits the transmission information to the destination apparatus by facsimile transmission through the communication network, when said facsimile communication unit has been designated by said communication designating unit (see col.3, lines 30-35), and said electronic-mail communication unit sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication unit has been designated by said communication designating unit(see col.2 lines 31-35 and col.2, lines 30-35). Gordon does not explicitly teaches of an input unit adapted to input transmission information to be transmitted to the destination apparatus designated by said destination designating unit without using the communication network, but it is

inherent that all devices uses for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner (see Fig.1), all have an input means such as number pad, keyboard, mouse, and software to input telephone numbers or type email addresses.

Dependent:

As per claims 2-3 and 11-12, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 1 and 10, and a computer-readable recording medium storing a computer program for implementing functions described in claims 1 and 10 (see col.6 lines 18-20).

As per claims 4, 5, and 13, Gordon further teaches wherein, if the destination apparatus possesses a private security function, said facsimile communication means checks to determine whether the destination apparatus possesses a private security function by inquiring as to whether the destination apparatus possesses the private security function when a communication path to the destination apparatus is formed and transmits the transmission information by confidential communication utilizing the private security function, when the transmission information has been designated as being confidential information by said security designating means (see col.9 lines 18-28).

As per claims 6, 7, 14, and 15, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 5 and 13 and a computer-readable recording medium storing a computer program for

implementing functions described in claims 5 and 13 (see col.6 lines 18-20 and col.10 lines 21-23).

As per claims 8, Gordon further teaches wherein said security designating means makes a determination that the transmission information is confidential information when transmission by confidential communication is designated (see col.6 lines 28-33).

As per claims 9 and 16, Gordon further teaches wherein said input means comprises a document reader and the transmission information, is inputted by reading a document using the document reader (see col.1 lines 5-10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US Pat No.5608786) in view of Yamada (US Pat No.5521719). Gordon teaches all the limitations of claim 17 including wherein the communication network includes at least a telephone network, but he does not teach that the communication network includes a LAN. Yamada teaches wherein the communication network includes at least a telephone network and a LAN (see Fig.9, #117 & #123 and col.4, lines 43-48). It would

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have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Yamada within the system of Gordon by implementing a LAN network and a PSTN network within the communication apparatus and method because, Gordon teaches us that other networks may be employed (see col.10, lines 6-9), thus it would be obvious to employ Local Area Network if there was a demand for such a network for this system.

***Response to Arguments***

4. Applicant's arguments filed September 16, 2003 have been fully considered but they are not persuasive. Explanations of the reasons are stated below.

A. In response to the argument on last paragraph on page 11 of the amendment, an "input means for inputting information to be transmitted to... without using the communication network" is clearly inherent as explained above. Furthermore, one of ordinary skill in the art would concur Fig.1, #12, #16, #18, #22 all comprise an input means such as a keyboard and/or mouse.

B. In response to the argument on last paragraph on page 11 of the amendment, Gordon clearly teaches the element of encrypting the data before communication between the subscriber and the UniPost.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view

of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The method and means of encrypting data before transmission, is well known and widely implemented in the area of cryptography, whereby data is encrypted and transmitted along a path with a corresponding key. This element of the claim is neither novel or considered an invention unless it is recited in the claim, the functional novel means by which the element overcomes prior art.

C. With respect to the responses recited above claims 1-18 remain rejected.

*Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



November 4, 2003



HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER